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EXAMINER

DUCHENEAUX, FRANK D

ART UNIT

PAPER NUMBER

1787

NOTIFICATION DATE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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Attachment to Advisory Action

The proposed amendments to the claims, filed 4/22/2010, have cancelled claims 5-7, 12 and 14 and imported at least some of the limitations of cancelled claims 6-7 and 14 into independent claim 1. The proposed amendments have also removed the crosslinking system limitations; have restricted the coated mixture to 1 to 15 parts by weight of an isocyanate; and changed the direct dependency of claim 8 from claim 7 to claim 13, the direct dependency of claim 15 from claim 6 to claim 1, and the direct dependency of claim 16 from claim 7 to claim 1. The proposed amendments also include an amendment to the specification to overcome the objections set forth in the previous action. The amendments have been fully considered but are not entered for the reasons set forth below.

The proposed amendments have not been entered given that the current amendments have altered the scope of the current invention and thus require further consideration and a new search for relevant art; specifically, the crosslinking system is limited only to an isocyanate in the amounts set forth in independent claim 1 of the proposed amendments. The examiner notes that the isocyanate used in an amount of 1 to 15 parts by weight in the claims filed 12/3/2009 were used in the alternative as set forth in claim 14, whereas the proposed current amendments require the isocyanate used in an amount of 1 to 15 parts by weight.

The applicants argue that Centner teaches a monomer (f) is emulsion polymerized with the other monomers, whereas the isocyanate crosslinking agent of the proposed current claims is

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added following polymerization of the acrylic and is therefore not emulsion polymerized. The applicants also argue that Centner is silent to a support layer having one or more layers comprised of one or more specific copolymers.

The examiner respectfully disagrees with the applicants' characterization of both the requirements of the claims filed 12/3/2009 and the disclosure of the Centner reference. The examiner notes that said claims require an acrylic dispersion obtainable via emulsion polymerization, but do not require that the crosslinking system be external to the acrylic polymer and therefore, the monomer (f) as taught by Centner in combination with the epoxy functional groups as taught by the analogous Peters reference teach all the limitations of said claims. The examiner also notes that the applicants' arguments with respect to the specific recitation of an isocyanate are based upon entry of the currently proposed amendments, which have not been entered as set forth above. Furthermore, even if the currently proposed amendments were entered, the Centner reference clearly teaches a backing, or support, made of polyolefins as set forth in the previous action and in paragraphs 0104-0105 of the reference, and in combination with the analogous Nakagawa reference, also set forth in the previous action, would clearly teach the support layer limitations of the currently proposed amendments to claim 1.

The applicants continue to argue that the adhesive composition of Centner would have too great an adhesion relative to the current invention for use with auto or motor vehicle bodies, which would not lead an artisan to the adhesive of Centner for such purposes given that the high adhesion would leave residues on an auto body.

In response, the examiner notes that the previous and currently proposed claims are directed to an adhesive film suitable for protecting motor vehicle bodies; however, there is no requirement in any of the claims stipulating to which portion or portions of said bodies the current invention is to be applied. Given that a motor vehicle body surface to which the current invention may be applied may be made of different materials (i.e. fiberglass, metal, plastic, painted surfaces), there is no supported evidence that the Centner adhesive would not adhere residuelessly to one or any of a motor vehicle's surfaces.

Additionally, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding the adhesive strengths of the adhesives disclosed by the Centner reference versus those of the current invention must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001."

The applicants further argue that the Peter reference fails to remedy clear deficiencies, i.e. an isocyanate crosslinking agent, and that hydroxyl groups are required for crosslink isocyanates, while the current invention does not require a polymer bearing hydroxyl groups. The applicants also note that it would have been unexpected to find that isocyanates can crosslink a polymer that do not bear hydroxyl groups. The applicants finally assert that the Peters reference teaches a

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combined by weight percentage of 2-ethylhexyl acrylate and ethyl acrylate less than 30 % and assert that such a low amount would not provide sufficient adhesion for use in films designed for protecting motor vehicle bodies.

In rebuttal, the examiner notes the following: First, as noted above with respect to the isocyanate limitation, the proposed amendments to claim 1 have not been entered and as such, applicants' arguments against either of the Centner and Peters references in this regard are moot. Second, it is unclear to the examiner how the applicants can argue that the current invention does not require an acrylic polymer having hydroxyl functionality given that claim 1, both previous and proposed, clearly recite from 2 to 5% by weight of monomers having a carboxylic group, which is further defined as being selected from acids (see claim 2 and page 4, lines 8-12 of the specification). Clarification is requested. Third, note that while Peters does not disclose all the features of the present claimed invention, Peters is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely epoxy functional groups for imparting crosslinkability, and in combination with the primary reference, discloses the presently claimed (filed 12/3/2009) invention.

/FRANK D DUCHENEAUX/
Examiner, Art Unit 1787

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787